

C4
Concl

24. (Once Amended) The method of claim 23, wherein one of said instruct signal [or] and said control signal is embedded in the non-visible portion of one of a television signal [or] and one of a multichannel broadcast [or] and a cablecast signal which contains video.

II. REMARKS

A. Introduction

The First Office Action dated January 27, 1998 (First Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 1-6, 8-9 & 11-24 are amended. Claims 2-24 are pending in the application.

Claims 13-22 are rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claim 14 of U.S. Pat. No. 5,335,277 in view of Haselwood et al., U.S. Pat. No. 4,025,851.

Claims 2-24 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 2 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over "Microprocessor for CATV Systems," by Tunmann et al. in view of Haselwood et al., U.S. Pat. No. 4,025,851.

Claim 3 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Flynn, U.S. Pat. No. 3,761,888.

Claim 8-12 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over the publication "Videocassette Banks Automate Delayed Satellite Programming," by Chiddix.

Claims 13-22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Cox et al., U.S. Pat. No. 4,388,645 in view of Haselwood et al., U.S. Pat. No. 4,025,851.

Claims 23-24 are not rejected over the prior art of record and Applicants assume that claims 23-24 would be allowable once the 35 U.S.C. § 112, first and second paragraph rejections have been overcome.

Claims 2-24 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

B. Summary of the Amendments to the Claims

Claims 1-6, 8, 11-21 & 23-24 have been amended to increase the clarity of the language of the claims. All alternative language using the word "or" has been replaced with -- one of ...and ... --. Additionally, every use of "one or more" has been replaced with -- at least one... --.

C. Response to the Rejection Under the Judicially Created Doctrine of Obvious-Type Double Patenting.

Claims 13-22 are rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claim 14 of U.S. Pat. No. 5,335,277 in view of Haselwood et al., U.S. Pat. No. 4,025,851.

Claim 13 of the instant Application	Claim 14 of U.S. Pat. No. 5,335,277
<p>A method of communicating data and update material to a network of a plurality of data receiver stations each of which includes one of a broadcast and a cablecast data receiver, a data storage device, a control signal detector, a computer capable of processing said data, with each of said plurality of data receiver stations adapted to detect and respond to at least one instruct signal and to store at least one datum of said data for subsequent processing, wherein a first of said plurality of data receiver stations further includes an intermediate transmitter, said method comprising the steps of:</p> <p style="padding-left: 40px;">receiving said data and delivering said data to at least one origination transmitter;</p> <p style="padding-left: 40px;">receiving said at least one instruct signal wherein said at least one instruct signal is effective in said network to cause said first of said plurality of receiver stations to transmit said data to a second of said plurality of receiver stations according to a transmission schedule and one of said first and said second of said plurality of receiver stations to log transmission of said data;</p> <p style="padding-left: 40px;">transferring said at least one instruct signal to said at least one origination transmitter; and</p> <p style="padding-left: 40px;">transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal.</p>	<p>A television receiver station comprising:</p> <p>a plurality of receiver/distributors with at least one receiving a television programming transmission, each transmission including the television programming and programming identification signals identifying the programming,</p> <p>an output device for displaying television programming or transmitting television programming to a remote subscriber station;</p> <p>a storage device for receiving and storing television programming;</p> <p>means for selectively receiving television programming from either one of said receiver/distributors or said storage device and selectively transferring the received television programming to either said storage device or to said output device;</p> <p>a processor operatively connected to at least one of said plurality of receiver/distributors for receiving the programming and the programming identification information; and</p> <p>a controller operatively connected to said processor for receiving specific unit programming identification information, identifying a specific unit of television programming received at a specific receiver/distributor by comparing of received identification information to previously received scheduled program identification information, and passing programming to either said output device or to said storage device based upon said scheduled information.</p>

With respect to Applicants' amended claim 13, U.S. Pat. No. 5,335,277 in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving said data and delivering said data to at least one origination transmitter. There is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of receiving data and delivering data to at least one origination transmitter.

There is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of receiving said at least one instruct signal

wherein said at least one instruct signal is effective in said network to cause said first of said plurality of receiver stations to transmit said data to a second of said plurality of receiver stations according to a transmission schedule and one of said first and said second of said plurality of receiver stations to log transmission of said data.

There is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of transferring said at least one instruct signal to said at least one origination transmitter.

Finally, there is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal.

The First Office Action fails to specifically reject Applicants' claim 18 with respect to the double patenting rejection. However, Applicants will respond accordingly. With respect to Applicants' amended claim 18, U.S. Pat. No. 5,335,277 in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving a program and delivering said program to at least one origination transmitter, wherein said program includes one of (i) audio and (ii) a command which executes processor instructions contained in said program.

There is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of receiving said at least one instruct signal wherein said at least one instruct signal is operative in said network to transmit said program from said intermediate transmitter according to a transmission schedule and log transmission of said program from one of said at least one origination transmitter at said intermediate transmitter.

There is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of transferring said at least one instruct signal to said at least one origination transmitter.

Finally, there is no teaching or suggestion in Haselwood et al. or in the claim language of U.S. Pat. No. 5,335,277 of transmitting from said at least one origination transmitter an information transmission comprising said program and said at least one instruct signal.

Applicants therefore respectfully request the rejection under the judicially created doctrine of obvious-type double patenting be withdrawn in view of the current claim amendments further clarifying Applicants' invention over the prior art of record.

**D. Response to Requirement Imposed Upon
Applicants to Resolve Alleged Conflicts Between
Applicants' Applications.**

Applicants respectfully traverse the requirements of the First Office Action paragraph 7.

Paragraph 7 of the First Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an
Unlawfully Promulgated Substantive Rule
Outside the Commissioner's Statutory Grant
of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the

Commissioner to promulgate regulations directed only to “the conduct of proceedings in the [PTO]”. This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).¹ Applicants respectfully submit that the Examiner’s creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO’s Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule’s impact on the Applicants’ rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference

¹Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

a. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).² These two well established types of double patenting use an

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis.

Once obviousness-type double patenting analysis has been applied and

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a substantive rule beyond the authority of the PTO and is therefore, invalid.

b. The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their

invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant First Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the First Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the First Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the First Office Action's result of abandonment of Applicants' application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the First Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the First Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending

applications.” Absent any evidence of conflicting claims between the Applicants’ present application and any other of Applicants’ co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants’ right to appeal, etc. Once obviousness-type double

patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

E. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 12/4/95, 4/5/96 and 4/7/97 and have addressed those specific concerns raised in paragraph 8 of the First Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 9/11/87,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the

International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the First Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

"[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application."

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination

process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants’ Latest Effective Filing Date of 9/11/87

Examiner stated “[n]umerous references listed in the IDS are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants’ understanding that the effective filing date for the present application is 9/11/87.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have

reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

F. Response to Rejections under 35 U.S.C. § 112

1. Specification Support of Claims 2-24

Paragraph 9 of the First Office Action rejects claims 2-24 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a. Claim 2

"inputting a signal and a transmission schedule associated with said signal, said transmission schedule comprising a code designating said signal and at least one of (1) a time at which to transmit said signal; and (2) a channel on which to transmit said signal;	Column 10 lines 61-63 with column 4 lines 5-13. Column 11 lines 21-31 & 39-43. Column 11 lines 22-25. Column 11 lines 28-31.
transmitting said signal according to a said schedule,	Column 11 lines 50-57.
selecting said code and an identifier associated with said signal,	Column 11 lines 38-40.
and "logging the transmission of said signal".	Column 12 lines 46-54, specifically line 54.

b. Claim 3

selecting one of the group consisting of: (1) a time at which to communicate; and (2) a memory location to which to communicate;	E.g., column 11 lines 57-64, including "incoming" and "instructs" at lines 58 and 62. For example, "when" at column 11 line 26. E.g., column 11 lines 60-61, including "selects" at line 60.
--	---

With respect to the First Office Action's rejection of Applicants' claim language of "one or more instruct signals which...", Applicants have amended the claim language to recite -- at least one instruct signal --.

c. Claim 8

encoding said instruction, said step of encoding translating said instruction to a control signal, said control signal for directing a processor at a user station to perform said effect indicated by said instruction with said program, said	For example, column 9 lines 31-33. For example, column 11 lines 38-39 and column 4 lines 5-30.
---	--

control signal interacting with predetermined user data, said predetermined user data being potentially different at each of said plurality of user stations; and	
storing said control signal from said step of encoding in conjunction with said program.	For example, column 11 lines 38-39 and 65 with column 4 lines 5-13.

d. Claims 9 & 10

The First Office Action states:

it is not clear where the disclosure as originally filed provided support for the recitation of the instruct signal recited in claim 8, e.g. which is encoded to form the recited control signal, and which further: 1) *effects a user station to transmit a program containing video information according to a transmission schedule*; 2) *effects said user station to log transmission of said program*; and 3) *directs the processor of said user station to generate a video overlay coordinated with said video information in said program. (Emphasis added.)*

However, the above recited language appears nowhere in the instant application.

Therefore, Applicants respectfully request that the rejection of claims 9 & 10 be withdrawn due to being improperly rejected.

e. Claim 13

As it is today, "Wall Street Week" was in 1981 a well known Public Broadcasting System program that originated in Owings Mills, Maryland and was rebroadcast all over the United States. The "television studio originating ['Wall Street Week']" is disclosed at column 19 lines 61-62. As an "[illustration of] one instance of ... the use of Signal Processing Apparatus and Methods ... a cable television system ... that cablecasts several channels of television programming" is disclosed at column 10 lines 24-28. Among the "programming being cablecast on the multi-channel system ... 'Wall Street Week' is being televised on channel X. " (column 19 lines 14-23)

Like "Wall Street Week", the programming of Julia Child, including "the French Chef," was in 1981 well known Public Broadcasting System television programming. Julia Childs's "The French Chef" is such program is disclosed at column 20 lines 19-20.

receiving said data and delivering said data to at least one origination transmitter;	E.g., column 19 lines 61-63.
receiving said at least one instruct signal wherein said at least one instruct signal is effective in said network to cause said first of said plurality of receiver stations to transmit said data to a second of said plurality of receiver stations according to a transmission schedule and one of said first and said second of said plurality of receiver stations to log transmission of said data;	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 and column 18 lines 39-42; plus column 12 lines 46-54, including "logs" at column 12 line 54.
transferring said at least one instruct signal to said at least one origination transmitter; and	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 61-63.
transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal.	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 61-63.

f. Claim 15

wherein two of said plurality of receiver stations one of receives and responds to said at least one instruct signal concurrently.	Column 3 lines 48-51. Column 19 lines 14-29. "Wall Street Week" is-and was in 1981-- a well known program televised each week to a large television audience. One of ordinary skill in the art would have readily understood that a plurality of receiver stations receive and respond to the instruct signal concurrently.
--	---

g. Claim 16

wherein each of said plurality of receiver stations responds to said at least one instruct signal at a different time.	Column 11 lines 38-57, and column 19 lines 14-29. "Wall Street Week" is-and was in 1981-- a well known program first televised every Friday evening and also rebroadcast by Public Broadcasting System stations subsequently over the weekend. One of ordinary skill in the art would have readily
--	---

	understood that a plurality of receiver stations receive and respond to the instruct signal at different times.
--	---

h. Claim 17

further comprising the steps of receiving said data at a receiver, communicating said data from said receiver to a memory location, and storing said data at said memory location for a period of time prior to communicating said data to one of said at least one origination transmitter and said intermediate transmitter.	Column 11 lines 32-39. Column 11 lines 57-64. Column 11 lines 59-60 and 64-65. Column 19 lines 61-63. Column 10 lines 49-52 with column 11 lines 38-46.
--	---

i. Claim 18

As it is today, "Wall Street Week" was in 1981 a well known Public Broadcasting System program that originated in Owings Mills, Maryland and was rebroadcast all over the United States. The "television studio originating ['Wall Street Week']" is disclosed at column 19 lines 61-62. As an "[illustration of] one instance of ... the use of Signal Processing Apparatus and Methods ... a cable television system ... that cablecasts several channels of television programming" is disclosed at column 10 lines 24-28. Among the "programming being cablecast on the multi-channel system ... 'Wall Street Week' is being televised on channel X. " (column 19 lines 14-23)

Like "Wall Street Week", the programming of Julia Child, including "the French Chef," was in 1981 well known Public Broadcasting System television programming. Julia Childs's "The French Chef" is such program is disclosed at column 20 lines 19-20.

receiving a program and delivering said program to at least one origination transmitter, wherein said program includes on of (i) audio and (ii) a command which executes processor instructions contained in	E.g., column 19 lines 60-63, and column 19 lines 54-55 or lines 45-53, including "upon command" at line 53 with column 19 line 63 to column 20 line 1.
--	--

said program;	
receiving said at least one instruct signal wherein said at least one instruct signal is operative in said network to transmit said program from said intermediate transmitter according to a transmission schedule and log transmission of said program from one of said at least one origination transmitter at said intermediate transmitter;	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 and column 18 lines 39-42; plus column 12 lines 46-54, including "logs" at column 12 line 54.
transferring said at least one instruct signal to said at least one origination transmitter; and	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 61-63.
transmitting from said at least one origination transmitter an information transmission comprising said program and said at least one instruct signal.	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 60-63 and column 19 lines 9-23 and column 18 lines 39-42; plus column 12 lines 46-54, including "logs" at column 12 line 54.

j. **Claim 20**

wherein two of said plurality of receiver stations one of receive and respond to said at least one instruct signal concurrently.	Column 3 lines 48-51. Column 19 lines 14-29. "Wall Street Week" is-and was in 1981-- a well known program televised each week to a large television audience. One of ordinary skill in the art would have readily understood that a plurality of receiver stations receive and respond to the instruct signal concurrently.
--	---

k. **Claim 21**

wherein each of said plurality of receiver stations responds to said at least one instruct signal at a different time.	Column 11 lines 38-57, and column 19 lines 14-29. "Wall Street Week" is-and was in 1981-- a well known program first televised every Friday evening and also rebroadcast by Public Broadcasting System stations subsequently over the weekend. One of ordinary skill in the art would have readily understood that a plurality of receiver stations receive and respond to the instruct signal at different times.
--	---

l. **Claim 22**

further comprising the steps of receiving said program at a receiver in a transmitter station, communicating said program from said receiver to a memory location, and storing said	Column 11 lines 32-39. Column 11 lines 57-64. Column 11 lines 59-60 and 64-65.
---	--

program at said memory location for a period of time prior to communicating said program to said intermediate transmitter.	Column 19 lines 61-63. Column 10 lines 49-52 with column 11 lines 38-46.
--	---

m. Claim 23

As it is today, "Wall Street Week" was in 1981 a well known Public Broadcasting System program that originated in Owings Mills, Maryland and was rebroadcast all over the United States. The "television studio originating ['Wall Street Week']" is disclosed at column 19 lines 61-62. As an "[illustration of] one instance of ... the use of Signal Processing Apparatus and Methods ... a cable television system ... that cablecasts several channels of television programming" is disclosed at column 10 lines 24-28. Among the "programming being cablecast on the multi-channel system ... 'Wall Street Week' is being televised on channel X. " (column 19 lines 14-23)

Like "Wall Street Week", the programming of Julia Child, including "the French Chef," was in 1981 well known Public Broadcasting System television programming. Julia Childs's "The French Chef" is such program is disclosed at column 20 lines 19-20.

receiving at one of a broadcast and a cablecast transmitter station an instruct signal which is effective at said plurality of receiver stations to transmit said instruct signal according to a transmission schedule and log transmission of said instruct signal;	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 and column 19 lines 9-23 and column 18 lines 39-42; plus column 12 lines 46-54, including "logs" at column 12 line 54.
transferring said instruct signal to a transmitter at said transmitter station;	E.g., column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 61-63; e.g., column 11 lines 50-57.
receiving at least one control signal at said transmitter station, said at least one control signal designating at least one receiver station of said plurality of receiver stations to which said instruct signal is addressed; and	E.g., column 17 lines 39-46 with either column 11 lines 3-43 or, for example, column 18 line 43 through column 19 line 4.
transferring said at least one control	E.g., column 17 lines 39-46 with column 19 lines 60-64 as well as

signal from said transmitter station to said transmitter at said transmitter station, said transmitter station one of broadcasting and cablecasting said instruct signal and said at least one control signal to said plurality of receiver stations;	column 11 lines 38-42, including "identification signals on the incoming programming" at lines 38-39 and column 19 lines 9-23 with column 19 lines 61-63.
---	---

2. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 2-24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

With respect to claim 2, the preamble has been changed to -- a method of transmitting signals --.

With respect to claim 3, "a potential user station" Applicants have deleted the term "potential." The duplicate "and" in claims 3, 8, 13 & 23 has been deleted.

Additionally, with respect to claim 3 regarding "said first instruct signal," the claim language has been changed to:

...selecting one of the group consisting of:

- (1) a time at which to communicate; and
- (2) a memory location to which to communicate;

communicating a first of said at least one instruct signal one of at said selected time and to said selected memory location; and

storing said programming signal and said first instruct signal at said storage device.

With respect to claim 8, the language has been changed to recite -- said instruction having an effect at said plurality of user stations to transmit said program according to a transmission schedule and log transmission of said program....-- Therefore, "said effect indicated by said instruction with said

program" relates to the "transmit" and "log" functions of the previously recited "effect." Regarding "said program" the last lines of claim 8 have been changed to -- storing said directing and interacting control signal from said step of encoding --.

With respect to claim 9, the preamble language now recites -- supplemental program material is stored at the location of said processor....--

With respect to claim 11, the language has been changed to recite -- (2) an instruction which is effective at a user station to generate some output to be associated with a product, service, or information presentation; --.

With respect to claims 13, 14, 15 & 16, "said one or more instruct signals" has been changed to -- at least one instruct signal --.

With respect to claim 17, "said data unit" has been changed to -- said data --. Additionally, to said transmitter" has been changed to -- to one of said broadcast and said cablecast transmitter --.

With respect to claim 18, "said one or more instruct signals" has been changed to -- at least one instruct signal --.

With respect to claim 23, the language -- thereby controlling a network of a plurality of receiver stations -- has been added to the end of the claim to be consistent with the preamble.

Additionally, claim 23 now recites -- (2) transferring said instruct signal to a transmitter at said transmitter station --; and "said at least one control signal designating at least one receiver station of said plurality of receiver stations to which said instruct signal is addressed... --.

3. Conclusion

Applicants respectfully submit that claims 2-24 and amended claims 1-6, 8-9, 11-21 & 23-24 of the subject application particularly point out and claim the

subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. § 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

G. Response to Obviousness Rejection of Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

1. **35 U.S.C. § 103 (a) Rejection over Tunmann et al. in view of Haselwood et al., U.S. Pat. No. 4,025,851.**

Claim 2 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over "Microprocessor for CATV Systems," by Tunmann et al. in view of Haselwood et al., U.S. Pat. No. 4,025,851.

With respect to Applicants' amended claim 2, Tunmann et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., inputting a signal and a transmission schedule associated with said signal, said transmission schedule comprising a code designating said signal and at least one of: (1) a time at which to transmit said signal; and (2) a channel on which to transmit said signal. Neither Tunmann et al. alone nor in combination with Haselwood et al. teach or suggest a code designating said signal and at least one of: (1) a time at which to transmit said signal; and (2) a channel on which to transmit said signal.

Since neither Tunmann et al. alone nor in combination with Haselwood et al. teach or suggest a transmission schedule associated with said signal, said transmission schedule comprising a code designating said signal, then neither Tunmann et al. alone nor in combination with Haselwood et al. teaches or suggests transmitting said signal according to said schedule.

Neither Tunmann et al. alone nor in combination with Haselwood et al. teach or suggest selecting one of said code and an identifier associated with said signal

Finally, neither Tunmann et al. alone nor in combination with Haselwood et al. teach or suggest logging said step of transmitting said signal, since neither

Tunmann et al. alone nor in combination with Haselwood et al. teach or suggest transmitting said signal according to said schedule.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 2 be withdrawn.

2. 35 U.S.C. § 103 (a) Rejection over Flynn, U.S. Pat. No. 3,761,888.

Claim 3-7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Flynn, U.S. Pat. No. 3,761,888.

With respect to Applicants' amended claim 3, Flynn fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving a programming signal which contains mass medium programming and communicating said programming signal to a storage device. Flynn specifically fails to teach communicating a programming signal to a storage device, since the First Office Action's equivalent of Applicants' storage device are Flynn's cartridge/cassette source 24 and reel-to-reel source 34. There is no teaching nor suggestion of communicating a programming signal to either the cartridge/cassette source 24 and reel-to-reel source 34. Flynn merely discloses that both sources are for playback purposes only.

Flynn fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving at least one instruct signal which is effective to instruct a first of said plurality of user stations to transmit said programming signal according to a transmission schedule and one of said first of said plurality of user stations and a second of said plurality of user stations to log a transmission record of said programming signal. Flynn fails to teach receiving at least one instruct signal. Applicants agree that the pre-programmed sequence controller 14 comprises an automation system (column 4, lines 24-25). However, there is no teaching or

suggestion in Flynn of receiving at least one instruct signal which is effective to instruct...and to log a transmission record of said programming signal.

Additionally, Flynn fails to, *inter alia*, teach or suggest all the claim recitations, i.e., selecting one of the group consisting of: (1) a time at which to communicate; and (2) a memory location to which to communicate. Flynn fails to teach selecting a time at which to communicate in that the program controller 14 ordinarily starts and stops the various sources in the sequence in which they are called for by a preset program. (Column 5, lines 7-10.) There is no teaching or suggesting in Flynn that a time at which to communicate is selected, rather than responded to in a "preset program." Additionally, Flynn fails to teach or suggest and the First Office Action fails to address selecting a memory location to which to communicate.

Since Flynn fails to teach or suggest selecting one of the group consisting of: (1) a time at which to communicate; and (2) a memory location to which to communicate, then Flynn fails to teach the subsequent step of communicating a first of said at least one instruct signal one of at said selected time and to said selected memory location.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 3 be withdrawn.

Claims 4-7 depends upon independent claim 3. As discussed *supra*, Flynn fails to disclose every element of claim 3 and thus, *ipso facto*, Flynn fails to anticipate dependent claims 4-7, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

3. 35 U.S.C. § 103 (a) Rejection over Chiddix.

Claim 8-11 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over the publication "Videocassette Banks Automate Delayed Satellite Programming," by Chiddix.

With respect to Applicants' amended claim 8, Chiddix fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving an instruction, said instruction having an effect at said plurality of user stations to transmit said program according to a transmission schedule and to log a transmission record of said program. Chiddix merely teaches that:

cue track information carried on the satellite may be recorded on a second audio track, so that commercials may be inserted on a normal basis during playback. By using capstan-servoed video-cassette machines and a moderately priced time-base corrector, the entire playback system may be locked to house sync for broadcast applications. (Page 39, column 3, lines 16-22.)

Nowhere in Chiddix is there a teaching or suggestion of an instruction having an effect at said plurality of user stations to transmit said program according to a transmission schedule and to log a transmission record of said program. The First Office Action assume that the above recited passage regarding the cue track is capable of performing in a similar manner to Applicants' claim language, but nowhere in Chiddix is there any mention to this effect. Therefore, Applicants respectfully traverse this rejection as an improperly construed hindsight rejection.

Chiddix fails to teach or suggest encoding said instruction, said step of encoding translating said instruction to a control signal, said control signal for directing a processor at a user station to perform said effect indicated by said instruction with said program, said control signal interacting with predetermined user data, said predetermined user data being potentially different at each of said plurality of user stations. Nowhere in Chiddix does it

suggest the encoding of Applicants' instruction to a control signal which directs a processor to perform a function. Based on the above recited passage of Chiddix upon which the Final Office Action relies, Applicants respectfully traverse the rejection as an improperly construed hindsight rejection.

Since Chiddix fails to teach translating said instruction to a control signal, Chiddix fails to teach Applicants' subsequent step of storing said directing and interacting control signal from said step of encoding.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 8 be withdrawn.

Claim 12 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over the publication "Videocassette Banks Automate Delayed Satellite Programming," by Chiddix in view of "The Vertical Interval: A General-Purpose Transmission Path," by Anderson.

However, claims 9-12 depend upon independent claim 8. As discussed *supra*, Chiddix alone and in view of Anderson fails to disclose every element of claim 8 and thus, *ipso facto*, neither Chiddix alone nor in combination with Anderson teaches or suggests dependent claims 9-12, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**4. 35 U.S.C. § 103 (a) Rejection over Cox et al.,
U.S. Pat. No. 4,388,645 in view of Haselwood
et al., U.S. Pat. No. 4,025,851.**

Claims 13-22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Cox et al., U.S. Pat. No. 4,388,645 in view of Haselwood et al., U.S. Pat. No. 4,025,851.

a. Independent Claim 13

With respect to Applicants' amended claim 13, Cox et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving said at least one instruct signal wherein said *at least one instruct signal* is effective in said network to cause said first of said plurality of receiver stations to identify said data and transmit said identified data to a second of said plurality of receiver stations according to a transmission schedule and to cause one of said first and said second of said plurality of receiver stations to log transmission of said identified data. Neither Cox et al. alone nor in combination with Haselwood et al. teaches or suggests an instruct signal (time codes of Cox et al.) which separately identifies the received data. The time codes of Cox et al. merely "determine when the associated programming guide page is to be rebroadcast by the head end facility," (column 4 line 58 to column 5 line 1), and fails to identify the received data.

With respect to Applicants' amended claim 13, Cox et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., with each of said plurality of data receiver stations adapted to detect and respond to at least one instruct signal and to store at least one datum of said data for subsequent processing. Neither Cox et al. alone nor in combination with Haselwood et al. teaches or suggests each of a plurality of data receiver stations adapted to both detect and respond to an instruction signal. Additionally, neither Cox et al. alone nor in combination with Haselwood et al. teaches or suggests storing store at least one datum of said data for subsequent processing.

Cox et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., transferring said at least one instruct signal to said at least one origination transmitter; and transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one

instruct signal. The First Office Action equates Applicants' instruct signal and transmission schedule with Cox et al.'s time codes of Fig. 3, specifically row 25.

Cox et al. with respect to the time codes teaches:

The time of day code included in row 25 is compared by decoder 22 with the time-on and time-off codes stored in row 24 of each page memory to determine when the associated programming guide page is to be rebroadcast by the head end facility. Thus, by suitably specifying the time-on and time-off codes associated with row 24 of each stored programming guide page, any sequence of pages may be automatically rebroadcast from the head end facility at selected times during the day without requiring any action or intervention on the part of the head end cable operator. (Column 4 line 58 to column 5 line 1.)

Cox et al. fails to teach or suggest transferring Cox et al.'s row 25 time codes to at least one origination transmitter; and transmitting one of a broadcast and a cablecast information transmission comprising data and the row 25 time codes subsequent to the operation of the time codes determine the rebroadcast of the associated programming guide page. Therefore, neither Cox et al. alone nor in combination with Haselwood et al. teach or suggest transferring said at least one instruct signal to said at least one origination transmitter; and transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal.

Finally, Applicants respectfully traverse the combination of Cox et al. with Haselwood et al. Cox et al. teaches the transmission of programming guide pages of teletext data from a satellite to a cable head end station. Haselwood et al. teaches the monitoring of transmitted television programming. There is no suggestion or motivation, neither in Cox et al. nor Haselwood et al., or in the knowledge generally available to one of ordinary skill in the art to modify Cox et al. to combine its teaching of programming guide pages of teletext data with the monitoring of transmitted television programming teaching of Haselwood et al.

Applicants maintain that there is no suggestion or motivation to combine these references and therefore the rejection is improper.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 13 be withdrawn.

Claims 14-17 depends upon independent claim 13. As discussed *supra*, Cox et al. in view of Haselwood et al. fails to disclose every element of claim 13 and thus, *ipso facto*, Cox et al. in view of Haselwood et al. fails to anticipate dependent claims 14-17, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

b. Independent Claim 18

With respect to Applicants' amended claim 18, Cox et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving said at least one instruct signal wherein said at least one instruct signal is operative in said network to identify said program and transmit said identified program from said intermediate transmitter according to a transmission schedule and log transmission of said identified program from one of said at least one origination transmitter at said intermediate transmitter. Neither Cox et al. alone nor in combination with Haselwood et al. teaches or suggests an instruct signal (time codes of Cox et al.) which separately identifies the received program. The time codes of Cox et al. merely "determine when the associated programming guide page is to be rebroadcast by the head end facility," (column 4 line 58 to column 5 line 1), and fails to identify the received program.

With respect to Applicants' amended claim 18, Cox et al. in view of Haselwood et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e.,

receiving a program...wherein said program includes on of (i) audio and (ii) a command which executes processor instructions contained in said program.

There is no mention in Cox et al. alone nor in combination with Haselwood et al. of a program which includes a command which executes processor instructions contained in said program.

Additionally, Cox et al. in view of Haselwood et al. fails to teach or suggest transferring said at least one instruct signal to said at least one origination transmitter; and transmitting one of a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal. The First Office Action equates Applicants' instruct signal and transmission schedule with Cox et al.'s time codes of Fig. 3, specifically row 25. Cox et al. with respect to the time codes teaches:

The time of day code included in row 25 is compared by decoder 22 with the time-on and time-off codes stored in row 24 of each page memory to determine when the associated programming guide page is to be rebroadcast by the head end facility. Thus, by suitably specifying the time-on and time-off codes associated with row 24 of each stored programming guide page, any sequence of pages may be automatically rebroadcast from the head end facility at selected times during the day without requiring any action or intervention on the part of the head end cable operator. (Column 4 line 58 to column 5 line 1.)

Cox et al. fails to teach or suggest transferring Cox et al.'s row 25 time codes to at least one origination transmitter; and transmitting one of a broadcast and a cablecast information transmission comprising data and the row 25 time codes subsequent to the operation of the time codes determine the rebroadcast of the associated programming guide page. Therefore, neither Cox et al. alone nor in combination with Haselwood et al. teach or suggest transferring said at least one instruct signal to said at least one origination transmitter; and transmitting one of

a broadcast and a cablecast information transmission comprising said data and said at least one instruct signal.

Finally, Applicants respectfully traverse the combination of Cox et al. with Haselwood et al. Cox et al. teaches the transmission of programming guide pages of teletext data from a satellite to a cable head end station. Haselwood et al. teaches the monitoring of transmitted television programming. There is no suggestion or motivation, neither in Cox et al. nor Haselwood et al., or in the knowledge generally available to one of ordinary skill in the art to modify Cox et al. to combine its teaching of programming guide pages of teletext data with the monitoring of transmitted television programming teaching of Haselwood et al. Applicants maintain that there is no suggestion or motivation to combine these references and therefore the rejection is improper.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 18 be withdrawn.

Claims 19-22 depends upon independent claim 18. As discussed *supra*, Cox et al. in view of Haselwood et al. fails to disclose every element of claim 18 and thus, *ipso facto*, Cox et al. in view of Haselwood et al. fails to anticipate dependent claims 19-22, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

H. Claims Not Rejected Over the Prior Art of Record

Claims 23-24 are not rejected over the prior art of record and Applicants assume that claims 23-24 would be allowable once the 35 U.S.C. § 112, first and second paragraph rejections have been overcome.

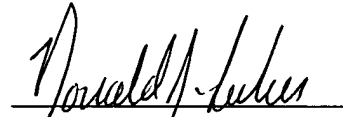
This Page Blank (uspto)

III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Respectfully submitted,



Thomas J. Scott, Jr.

Reg. No. 27,836

Donald J. Lecher

Reg. No. 41,933

Attorneys for Applicants

Tel: (202) 383-6790

Date: July 27, 1998
HOWREY & SIMON
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004